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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,224	01/22/2004	Melvin Lee Jacobson	J274.12-0001	9161
164	7590	12/27/2004		
KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002			EXAMINER ROWAN, KURT C	
			ART UNIT 3643	PAPER NUMBER

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/764,224	JACOBSON, MELVIN LEE	
	Examiner	Art Unit	
	Kurt Rowan	3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 19, 23, 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Marsh et al. 2002/0112395 A1 for substantially the same reasons stated in the first Office Action.

The Patent Application Publication '395 to Marsh shows an insect removal device 2 having an engagement surface (not labeled) covered with an adhesive layer 4, a backing side (not labeled) positioned opposite the engagement side, and a single release tab 6 covered with a tab liner 10 as shown in Fig. 1.

3. Claims 1-3, 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mike et al.

The patent to Mike shows an insect removal device from a surface having an engagement side covered with an adhesive layer 11-12, a backing side 7-8, positioned opposite the engagement side and a single release tab 6 covered with a tab liner 4 extending from the engagement side and the backing side for removing the engagement side from a surface.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5-7, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. in view of Mike et al.

The Patent Publication '395 to Marsh shows an insect removal device 2 having an engagement surface covered with an adhesive layer 4, a backing side positioned opposite the engagement side and a single release tab 6 covered with a tab liner 10 as shown in Fig. 1. The patent to Mike et al. shows an insect removal device having an engagement side covered with an adhesive layer 11-12, a backing side 7-8 positioned opposite the engagement side and a single release tab 6 covered with tab liner 4. The tab extends from the engagement side and the backing side. In reference to claim 1, it would have been obvious to provide Marsh with the tab as shown by Mike since merely one tab is being substituted for another and the function is the same noting that the tab of Mike provides additional reinforcement for the tab. In reference to claims 6-7, Marsh does not disclose alcohol. Marsh discloses that the adhesive layer is penetrated with an antiseptic in paragraph 16. In reference to claim 7, it would have been obvious to provide Marsh with alcohol which is an old and well known antiseptic. In reference to claim 16, Marsh shows the release tab 6 covered with a tab liner 10. In reference to claim 17, Marsh discloses a flexible, resilient foam material for both the main body 2

and release tab 6 in paragraph 0011. In reference to claim 29, Marsh does not disclose saving the pest attached to the pest removal device and then analyzing the pest for disease, but it would have been obvious to check the pest for disease to help determine if treatment was required.

5. Claims 8, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh '395 in view of Mike as applied to claim 1 above, and further in view of Nelson '862.

The patents to Marsh, Mike, and Nelson show insect capturing devices. Marsh and Mike have been discussed above and do not show the liner spooled in a dispenser. In reference to claim 8, the patent to Nelson shows a storing liner 50. In reference to claims 8 and 18, 20, it would have been obvious to provide the insect capturing device of Marsh as modified by Mike with a storing liner as shown by Nelson to conveniently carry more than one insect catcher at a time. The patent to Nelson shows an insect capturing device spooled on a dispenser in Figs. 9b and 16. In reference to claims 9 and 21, it would have been obvious to provide the insect capturing device of Marsh as modified by Mike with a spooled dispenser as shown by Nelson for the purpose of convenience and ease of use.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. in view of Mike as applied to claim 1 above, and further in view of Cosenza.

The patents to Marsh, Mike, and Cosenza show insect capturing devices. Marsh and Mike do not show adhesive on the backing side. The patent to Cosenza shows an insect capturing device with adhesive on the backing side. In reference to claim 10, it

would have been obvious to provide the insect capturing device of Marsh as modified by Mike with adhesive on the backing side as shown by Cosenza for the purpose of adhering the back side of the pest removal device to another object or picking up another insect.

7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh as modified by Mike and Nelson as applied to claim 20 above, and further in view of Cosenza.

The patents to Marsh, Mike, Nelson, and Cosenza show insect capturing devices and have been discussed above. In reference to claim 22, it would have been obvious to provide the insect catcher of Marsh as modified by Mike and Nelson with adhesive on both sides as shown by Cosenza to attach the insect catcher to other articles or to catch more insects.

8. Claims 12-14, 16, 17, 24, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. for substantially the same reasons stated in the first Office Action.

9. Claims 18, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. as applied to claim 12 above, and further in view of Nelson '862 for substantially the same reasons stated in the first Office Action.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. as applied to claim 12 above, and further in view of Cosenza for substantially the same reasons stated in the first Office Action.

11. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. as modified by Nelson as applied to claim 20, above, and further in view of Cosenza for substantially the same reasons stated in the first Office Action.

Response to Arguments

12. Applicant's arguments filed Sept. 27, 2004 have been fully considered but they are not persuasive. Applicants' arguments with respect to claims 1-3, 5 are moot in view of the new grounds of rejection. In regard to claim 19, Marsh shows a substrate having a first and second side as shown in Fig. 1. the first side has an engagement portion. In reference to claim 23, Marsh shows the equivalent structure disclosed for holding the pest removal device without contracting the means for securing since the tab 6 of Marsh is on the opposite side from the means for securing the pest. In reference to claim 25, applicant argues that Marsh does not show or disclose securing the pest removal device to the pest and surface. However, Fig. 4 of Marsh shows securing the pest removal device to the pest and the surface. In reference to claim 12, Marsh does show the tab extending from a perimeter of the device noting that Fig. 1 shows the device and the perimeter can be defined as the 6 lines that make up the outer surfaces of the device. Marsh then shows the tab 6 extending from the perimeter. Marsh shows the length of the tab to less than the length of the main body portion. The orientation of the tab is clearly a matter of design choice since no stated problem is solved as is the width of the tab being less than the main body width noting that changes in size and shape are obvious. See *In re Rose*, 105 USPQ 137, *In re Aller et al.*, 105 USPQ 233

and In re Dailey et al., 149 USPQ 47. In reference to claim 22, Marsh shows a single release tab with an adhesive layer that covers the engagement portion. In reference to claim 24, Marsh does not disclose a circular disk, but shows a rectangular device. However, it would have been obvious to employ a circular disk since changes in shape are obvious. See the citation to In re Dailey et al., above.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan
Primary Examiner
Art Unit 3643

KR